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Michelle P. Chicos

Printed name of person mailing correspondence

Michelle Chicos

Signature of person mailing correspondence

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE **RECEIVED**

Applicant: Robert A. Murgita

Art Unit: 1646

Serial No.: 08/879,469

Examiner: S. Gucker

Filed: June 20, 1997

Title: RECOMBINANT HUMAN ALPHA-FETOPROTEIN AS A CELL
PROLIFERATIVE AGENT

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Assistant Commissioner for Patents
Washington, D.C. 20231

OFFICE OF PETITIONS

PETITION TO WITHDRAW THE FINAL OFFICE ACTION
UNDER 37 C.F.R. §1.181

Applicant respectfully requests that the Patent and Trademark Office ("PTO") withdraw finality of the Office Action, mailed April 14, 2000, in connection with the above-referenced application.

The issuance of the final Office Action was premature, because it is a first action in the above-referenced application, which is a continuing application, accompanied by Amendments that were presented in the earlier application after final rejection, but were

not entered (see M.P.E.P. § 706.07(b)).

More specifically, the above-referenced application is a Continued Prosecution Application (CPA) of Application No. 08/879,469, filed June 20, 1997 ("the parent application"). A final Office action was issued on March 31, 1998, in the parent application. On September 30, 1998, Applicant filed a Reply to the Office action mailed March 31, 1998, addressing all the rejections, as well as a Notice of Appeal (copies of PTO date-stamped postcard and documents filed September 30, 1998 enclosed). No communication from the Examiner regarding the Reply filed September 30, 1998, was received.

Prior to the expiration of the period for filing an Appeal Brief in the parent application, on March 30, 1999, Applicant filed a CPA (as acknowledged in the final Office action mailed April 14, 2000), and filed a preliminary amendment on January 4, 2000, again addressing the issues raised in the parent application in the Office action mailed March 31, 1998 (copies of PTO date-stamped postcard and documents filed January 4, 2000 enclosed). In paragraph 2 of the final Office action, mailed April 14, 2000, however, the Examiner noted that no preliminary amendment had been filed with the CPA. This is clearly not the case; as discussed above, a preliminary amendment was filed January 4, 2000.

Accordingly, Applicant has, in the above-captioned case, presented material that has never before been entered (in neither the parent application on September 30, 1998,

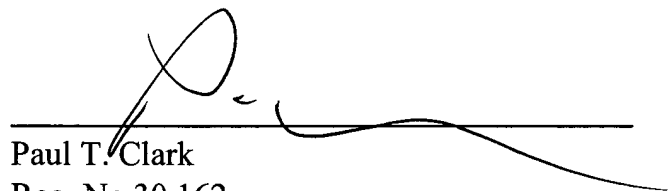
nor in the above-referenced application on January 4, 2000). Therefore, under M.P.E.P. § 706.07(b), a first action that is a final rejection is improper. The finality of the Office action mailed April 14, 2000 should be withdrawn.

CONCLUSION

For the reasons given above, the Patent and Trademark Office should withdraw the final Office action mailed on April 14, 2000. If there are any charges, or any credits, please apply them to Deposit Account No. 03-2095.

Respectfully submitted,

Date: Oct. 16, 2000


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